

REMARKS

The Examiner is thanked for the careful review of this application.

Claims 1-3, 5, 6, and 8-23 are pending in the present application. Claims 1, 5, 8, 11, and 14-19 are independent claims. In the subject paper, no amendments have been made to the claims. The Applicants believe that the present application is now in condition for allowance, which prompt and favorable action is respectfully requested.

Rejection under 35 U.S.C. § 112, 2nd Paragraph

Claims 5, 6, 11-13 and 17 are rejected under 35 U.S.C. § 112, 2nd Paragraph as allegedly being indefinite. The Applicants respectfully traverse this rejection.

The Office indicates that the written description is deficient for failing to explicitly describe the structure upon which the “means for” limitation can read upon. A “means for receiving” can correspond to a receiver, a “means for presenting” can correspond to some type of user-display, and so on. As noted by the Office on Pages 3-4 of the Office Action:

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

- (a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or
- (b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(0) and 2181.

Pursuant to option (b) presented above, the Applicants respectfully submit that the structure upon which each “means for” limitation reads is either implicitly or inherently disclosed in the Specification. For example, phone 120 as illustrated in FIG. 1 implicitly and/or inherently includes a receiver and transmitter, some type of display mechanism and a user input

mechanism (*e.g.*, a touchscreen, keyboard, etc.). Likewise, the application download servers shown in FIG. 2 implicitly and/or inherently include some type of receiver for receiving network data.

While the Applicants do not believe that an additional illustration of the components of the “means for” limitations is required because the illustration of the phone 120 in FIG. 1 and application download servers in FIG. 2 should be sufficient for supporting the “means for” claims, the Applicants will provide new drawings that include more explicitly these components if requested to do so by the Office. If the Office issues such a request, it is further requested by the Applicants that the Office indicate such FIGS. would be supported by the application as originally filed in order to expedite prosecution and avoid an objection to these FIGS.

The Applicants note that the first paragraph of 35 U.S.C. § 112, states that “[t]he specification shall contain a written description of the invention ... in such full, clear, concise, and exact terms as to enable any person skilled in the art ... to make and use the same...” Descriptive matter may be inherently present in a specification if one skilled in the art would necessarily recognize such a disclosure. *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

The Applicants respectfully request that the Office withdraw this rejection.

Rejections under 35 U.S.C. § 101

Claims 1-3, 5, 6 and 8-23 remain rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. The Applicants respectfully traverse this rejection.

Regarding claims 5, 6, 11-13 and 17, the Office indicates that these claims are simply a system defined by software. As such, the Office is attempting to read a means-for claim invoked under 35 U.S.C. § 112, 6th paragraph upon software-code. *However, 35 U.S.C. § 112, 6th prohibits the Office from making this interpretation.* 35 U.S.C. § 112, 6th paragraph recites the following:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding

structure, material, or acts described in the specification and equivalents thereof.
(e.g., see 35 U.S.C. § 112, 6th paragraph, Emphasis added)

As will be appreciated, the Office is not permitted to read a claim under 35 U.S.C. § 112, 6th paragraph upon mere program code or functional language, but is required by law to read such a claim upon corresponding “structure, material or acts,” each of which corresponds to a statutory category of invention. Accordingly, so long as there is support for corresponding “structure, material or acts” in the Specification (*see* preceding section, this support is implicit/inherent), the Office ***is required*** to read this claim only upon the statutory subject matter, irrespective of other non-statutory subject matter disclosed in the Specification.

Reading claims under 35 U.S.C. § 112, 6th paragraph upon non-statutory software is not in the Office’s discretion. Therefore, the issue becomes whether there is adequate support in the Specification to support a statutory interpretation of the means-for claims. This analysis does not fall under 35 U.S.C. § 101. Thus, even if the Office alleges there to be no support for a statutory interpretation of the rejected claims, the Office still needs to withdraw the 35 U.S.C. § 101 rejection.

Regarding claims 1-3, 8-10, 14-16, and 18-23, the Office indicates that the rejected claims are not “tied to a machine” and “may be performed within the human mind.” The Applicants respectfully disagree, and note that the preamble of the rejected independent claims recite a “method, performed by a communications device” (Emphasis added). Further, the receiving feature of claim 1, for example, is received “at the communications device.” A communications device is not a “human mind” as alleged by the Office, and as such this rejection as it pertains to claims 1-3, 8-10, 14-16 and 18-23 should be withdrawn for at least this reason.

In view of the foregoing remarks, the Applicants respectfully request withdrawal of this rejection.

CONCLUSION

In light of the amendments contained herein, Applicants submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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